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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,876	07/11/2001	Mauro Premutico	1212	9166
7590 11/09/2004 HIMANSHU S. AMIN AMIN & TUROCY, LLP 24TH FLOOR NATIONAL CITY CENTER 1900 EAST 9TH STREET CLEVELAND, OH 44114			EXAMINER NAWAZ, ASAD M	
			ART UNIT 2155	PAPER NUMBER

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/902,876	PREMUTICO, MAURO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Asad M Nawaz	2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-44 are presented for examination.
2. References in applicant's IDS, form 1449, have been considered.

### ***Drawings***

3. The drawings are objected to because they do not contain any reference numerals in figures 2-4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 9-19, 23-30, 34-37, and 41-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann et al (US Patent No. 6,779,022).

As to claim 1, Horstmann teaches a method for replying to a message from a designated device in an automated messaging system, the message being sent by a sender to an address associated with a host computer, said method comprising the steps of: a) configuring the host computer to forward messages to an address associated with the designated device; (Abstract)

b) sending a forwarded message from the host computer to said address associated with the designated device, said forwarded message being associated with the message sent to the address associated with the host computer; (Abstract; col 4, lines 8-18)

c) receiving the forwarded message on the designated device; (Abstract)

d) sending a reply message from the designated device to the sender, wherein the reply message includes originating information and wherein the originating information of the reply message is configured using information associated with the

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host computer; (Abstract; Fig 4; col 2, lines 38-41; col 5, lines 21-56; col 6, lines 1-16)  
and

e) sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message. (Fig 4; Col 6, 1-16)

Claims 13, 16, 27, and 34 are rejected for containing similar limitations as claim 1 above.

As to claim 2, Horstmann teaches the method of claim 1 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the sender. (Abstract; Fig 4; col 2, lines 38-41; col 5, lines 21-56; col 6, lines 1-16)

Claims 14, 17, 28, and 35 are rejected for containing similar limitations as claim 2 above.

As to claim 3, Horstmann teaches the method of claim 1 wherein the forwarded message includes originating information and wherein the originating information of the forwarded message is configured using information associated with sender. (Abstract; Fig 4; col 2, lines 38-41; col 5, lines 21-56; col 6, lines 1-16)

Claims 15, 18, 29, and 36 are rejected for containing similar limitations as claim 3 above.

As to claim 4, Horstmann teaches the method of claim 1 wherein the message sent to the address associated with the host computer is in a first file format and wherein the forwarded message is in a second file format, and wherein the method

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further comprises converting the first file format to the second file format. (abstract, col 1, lines 55-69)

Claims 19, 30, and 37 are rejected for containing similar limitations as claim 4 above.

As to claim 9, Horstmann teaches the method of claim 1 wherein the host computer only forwards messages of a certain type to the designated device. (Abstract; col 5, lines 57-67)

Claims 23 and 41 are rejected for containing similar limitations as claim 9 above.

As to claim 10, Horstmann teaches the method of claim 1 wherein the designated device is a mobile device. (Abstract, Fig 1, col4, lines 36-46)

Claims 24 and 42 are rejected for containing similar limitations as claim 10 above.

As to claim 11, Horstmann teaches the method of claim 1 wherein the message sent to the address associated with the host computer is an email message. (Abstract)

Claims 25 and 43 are rejected for containing similar limitations as claim 11 above.

As to claim 12, Horstmann teaches the method of claim 1 wherein the reply message is an email message. (Abstract)

Claims 26 and 43 are rejected for containing similar limitations as claim 12 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-6, 20-21, 31-32, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (US Patent No 6, 779, 022) further in view of Pepe et al( WO 97/33421).

As to claims 5 and 6, Horstmann teaches the method of claim 4 but does not explicitly indicate that the first file format is primarily a text format and wherein the second file format is primarily an audio format.

Pepe et al teaches a personal communications system in which a user can remotely control the delivery of wireless and wireline messages. These messages can be in one of many formats including voice and text. Furthermore, the system is capable of performing media translations, where necessary. (abstract)

It would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate the teachings of Horstman into those of Pepe to make the system easier to use. Although Horstmann does describe forwarded messages automatically being reformatted for the receiving device (col 1, lines 55-52) and that as an example, if the forwarded message was intended for a mobile phone that was unavailable, the message would be reformatted for a secondary device like a pager (col 2, lines 19-24), it does not explicitly indicate that the mobile phone is receiving voice

and the pager is receiving text. Pepe teaches the conversion from text to voice and vice versa in an analogous system. (Abstract)

Claims 20, 21, 31, 32, 38, and 39 are rejected for containing similar limitations as claims 5 and 6 above.

6. Claims 7-8, 22, 33, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (US Patent No 6, 779, 022) further in view of Lazaridis et al (US Patent No 6,219,694).

As to claims 7 and 8, Horstmann teaches the method of claim 1 but does not explicitly indicate that the sending of the copy message to the address associated with the host computer is not noticeable by the sender and further in a blind carbon copy format.

Lazaridis et al teaches an analogous system with the ability to forward messages to a designated device and receive a response from a designated device. The user at the designated device is able to see the original subject, sender's address, destination address, carbon copy, and blind carbon copy. When the user responds, these fields are available for use at the user's discretion. (col 9, lines 1-19)

It would have been obvious for one with ordinary skill in the art at the time of the invention to incorporate the teachings of Lazaridis into those of Horstmann to make the system more flexible. A user may want to send a copy to another address transparent to the first address. Rather than type the same message again and send the two



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messages separately, the blind carbon copy field, as is known in the art, remedies this problem.

Claims 22, 33, and 40 are rejected for containing similar limitations as claims 7 and 8 above.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M Nawaz whose telephone number is (703) 305-0094. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
AMN

  
**HOSAIN ALAM**  
SUPERVISORY PATENT EXAMINER

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